

## REMARKS

In this amendment, Patent Owner has canceled claim 76, amended claims 1, 52-59, 65, 66, and 78-86, and added new claims 87-147. Thus, claims 1-75 and 77-147 are pending. The amendment and addition of new claims is intended to overcome prior art issues arising from European Patent No. 402,644 to Strupczewski et al., published on December 19, 1990 (EP '644). These issues were brought to Patent Owner's attention in related U.S. Application Serial No. 08/468,611 (Attorney Docket No. 2489.0058).

Specifically, Patent Owner has amended claim 1 to remove  $R_{21}$  and  $R_{22}$  from the definition of  $R_1$  and to remove certain definitions of  $R$  and  $R_5$ . Patent Owner has also amended claim 1 and claims 78 and 79 to remove hydroxy and halogen from the definition of  $Y$  when  $p$  is 2. Accordingly, claims 1, 78, and 79, and claims dependent thereon have been amended to conform the definitions of  $R_1$ ,  $R$ ,  $R_5$ , and  $Y$  to those definitions recited in prior U.S. Application Serial No. 07/456,790, filed December 29, 1989, now abandoned (the '790 application). Claims 1, 78, and 79 and claims dependent thereon are therefore entitled to benefit of the December 29, 1989, filing date of the '790 application. Because EP '644 was published on December 19, 1990, i.e., after the filing date of the '790 application, EP '644 is not available as prior art under 35 U.S.C. §102 for these claims. Thus, claims 1, 78, and 79 and claims dependent thereon are not anticipated or rendered obvious by EP '644.

Patent Owner has added independent claims 87 and 104 to cover subject matter removed from original claim 1 of the '866 patent. Claim 87 is directed to the compounds of patented claim 1 wherein  $R_1$  is  $R_{21}$ , while claim 104 is directed to compounds of patented claim 1 wherein  $R_1$  is  $R_{22}$ . Dependent claims 88-103 and 105-119 correspond to patented claims 67-77 and 82-86.

EP '644 does not teach or suggest additional linking groups besides  $-(CH_2)_n-$ , as now recited in claims 87 and 104. In particular, EP '644 does not teach or suggest that the moiety linking the piperidine or piperazine ring to the phenoxy substituent may be an alkene or alkyne group (as required by claim 87), or a substituted alkane, alkene, or alkyne group (as required by claim 104). Thus, EP '644 does not teach or suggest new claims 87-119.

Patent Owner has also added independent claim 132 to cover subject matter removed from original claim 1 of the '866 patent. Claim 132 is directed to the compounds of patented claim 1 wherein at least one of the R substituents is selected from the group consisting of dialkylaminocarbonyl, formyl,  $-C(=W)-alkyl$ ,  $-C(=W)-aryl$ , and  $-C(=W)-heteroaryl$ . Dependent claims 133-147 correspond to patented claims 67-75, 77 and 82-86. EP '644 does not teach or suggest that at least one R group must be dialkylaminocarbonyl, formyl,  $-C(=W)-alkyl$ ,  $-C(=W)-aryl$ , or  $-C(=W)-heteroaryl$ . Thus, EP '644 does not teach or suggest new claims 132-147.

Patent Owner has also amended claim 80 to be dependent on claim 1 since it is directed to a subset of the broad genus of amended claim 1. Claim 80, as with claim 1, is entitled to benefit of the December 29, 1989, filing date of the '790 application. Because EP '644 was published on December 19, 1990, *i.e.*, after the filing date of the '790 application, EP '644 is not available as prior art under 35 U.S.C. §102 for amended claim 80. Thus, claim 80 and claims dependent thereon are not anticipated or rendered obvious by EP '644.

Newly added claim 120 is directed to a subset of the compounds of independent claim 87 (wherein  $R_1$  is  $R_{21}$ ) while claim 126 is directed to a subset of the compounds of independent claim 104 (wherein  $R_1$  is  $R_{22}$ ). Dependent claims 121-125 and 127-131 correspond to patented claims 82-86. EP '644 does not teach or suggest additional linking groups besides  $-(CH_2)_n-$ , as

now recited in claims 120 and 126. In particular, EP '644 does not teach or suggest that the moiety linking the piperidine or piperazine ring to the phenoxy substituent may be an alkene or alkyne group (as required by claim 120), or a substituted alkane, alkene, or alkyne group (as required by claim 126). Thus, EP '644 does not teach or suggest new claims 120-131.

Finally, claims 52-56 have been amended to be dependent on new claim 132 since amended claim 1 does not allow for R to be a dialkylaminocarbonyl, formyl, -C(=W)-alkyl, -C(=W)-aryl, or -C(=W)-heteroaryl group. Also, claims 57-59 and 81, directed to species where R<sub>1</sub> is an alkene group, have been amended to depend from new claim 87 since amended claim 1 does not allow for unsaturated groups in the R<sub>1</sub> position. Claims 65 and 66, directed to species where R<sub>1</sub> is a substituted alkyl group, have been amended to depend from new claim 104. Claim 76 has been canceled since claim 1 as amended no longer allows R<sub>1</sub> to be -CH<sub>2</sub>-CH=CH-CH<sub>2</sub>-.

Claims 82-86 have been amended to correct the dependency of these claims on claims 1-75 and 77-81.

For the foregoing reasons, Patent Owner respectfully submits that claims 1-75 and 77-147 are in condition for allowance, and early notification to this effect is courteously requested.

If there are any fees due in connection with the filing of this response not already accounted for, please charge the fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By: Lara C. Kelley  
Lara C. Kelley  
Reg. No. 41,551

Dated: November 15, 2000

LAW OFFICES  
FINNEGAN, HENDERSON,  
FARABOW, GARRETT,  
& DUNNER, L.L.P.  
1300 I STREET, N.W.  
WASHINGTON, DC 20005  
202-408-4000